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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/410,494	09/30/1999	KURT W. PIERSOL	74451.P107	6948

7590

01/05/2006

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EXAMINER
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WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/410,494

Applicant(s)

PIERSOL ET AL.

Examiner

Michael Y. Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25,30,31 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25,30,31 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the Request for Continued Examination and Amendment filed November 7, 2005.
2. Claims 1, 13, and 25 have been amended.
3. Claims 1-25, 30, 31, and 35-37 have been examined and are pending with this action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-7, 9, 10, 12-19, 21, 22, 24, 25, 30, 31, and 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Singhal (US 6370527 B1).

INDEPENDENT:

As per **claims 1 and 13**, Singhal teaches a method comprising and a machine-readable medium having stored thereon sequences of instructions that, when executed by one or more processors (see 7, lines 31-44), cause:

generating, automatically with an electronic system without user intervention (see col.2, lines 17-20), a private local network (see col.3, lines 15-29: “intranet” and “LAN”) search request (see col.3, lines 32-38) in response to an original search request (see col.1, lines 34-38), the local network search request to cause a search to be performed on electronic documents stored by a device that is part of a private local network and further wherein one or more of the documents are saved in the absence of an explicit command by the user to save the electronic documents and in response to another user specified function associated with the electronic documents (see col.3, lines 30-46), the search of the electronic documents on the local network to be performed according to search parameters of the original search request (see col.2, lines 17-20: “alleviate manually repeating the entry”);

generating, automatically (see col.2, lines 17-20) with the electronic system without having to wait for a search result of the local network search request from the local network and in addition to the local network search request (see col.1, lines 35-38 and col.2, lines 39-42), an external network search request (see col.3, lines 15-29:

“Internet” and “WAN”) in response to the original search request, the external network search request to cause a search to be performed on electronic documents available from devices that are part of an external public network via a network portal (see Fig.4, #210 and col.4, lines 19-21: network interface) of an external network according to the search parameters of the original search request (see col.1, lines 34-38); and

generating a single search report at the electronic device based on the search result of the private local network search request and the public external network search request (see col.1, lines 54-62: “compiled listing” and col.2, lines 43-46: “single ranked list”).

As per **claim 25**, Singhal teaches of an apparatus comprising:

a first device to automatically (see col.2, lines 17-20) capture electronic documents from a private local network (see col.3, lines 15-29: “intranet” and “LAN”);  
and

an application to be executed by the first device to search the captured electronic documents that have been saved in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents in response to a search request (see col.3, lines 30-46), wherein the application also generates an external document search request in response to the search request (implicit: see col.1, lines 32-41) substantially simultaneously without having to wait for a search result of the local network (see col.2, lines 39-42),

wherein the first device transmits the external document search request to a second device on an external public network (see col.1, lines 35-38: "plurality of search engine devices"), wherein the second device on the external public network performs the external document search request to generate a search of electronic documents from an external network (see col.3, lines 15-46), and

wherein the first device combines the private local network (see col.3, lines 15-29: "intranet" and "LAN") and the external public network (see col.3, lines 15-29: "Internet" and "WAN") search results to generate a single search report (see col.1, lines 54-62: "compiled listing" and col.2, lines 43-46: "single ranked list").

DEPENDENT:

As per **claims 2 and 14**, which depend on claims 1 and 13, respectively, Singhal further teaches wherein the local network device comprises a file management appliance (see Fig.3, #130: meta-search engine).

As per **claims 3 and 15**, which depend on claims 2 and 14, respectively, Singhal further teaches wherein the file management appliance generates the local network search request and the external network search request (see col.2, lines 43-46).

As per **claims 4 and 16**, which depend on claims 2 and 14, respectively, Singhal further teaches wherein the file management appliance performs a search of the unconsciously captured electronic documents in response to the local network search request (implicit: see col.2, line 17-20).

As per **claims 5 and 17**, which depend on claims 2 and 14, respectively, Singhal further teaches an Internet (see col.3, line 18) portal performs a search of the electronic documents available via a network portal of an external network in response to the external network search request (implicit).

As per **claims 6 and 18**, which depend on claims 1 and 13, respectively, Singhal further teaches wherein the local network search request and the external network search request are generated by a portal appliance in response to the original search request (see Fig.3).

As per **claims 7, 19, and 35**, which depend on claims 1, 13, and 25, respectively, Singhal further teaches generating a single search report is generated by combining at least a portion of content from the search results of the local network search request and the external network search request without revealing the associated unconsciously captured electronic documents of the local network to the external network and vice versa (implicit: see Fig.3 and Fig.6, the meta-search engine send the query to number of different search engines then receives the results of each for sorting, therefore, no data is shared among the different search engines in different networks).

As per **claims 9, 21, and 36**, which depend on claims 7, 19, and 25, respectively, Singhal further teaches wherein the single search report is generated by integrating the external and local network search results (see col.1, lines 39-41 and 54-62), wherein the external network search result specifies where and how the local network search result to be integrated into the external network search result in order to form the single search report (implicit: Singhal teaches of a scoring method (see col.10, lines 15-22) of

combining the results into a single list, therefore, it is implicit that the scores of both networks specifies where and how the search results of the other network is to be integrated).

As per **claims 10 and 22**, which depend on claims 7 and 19, respectively, Singhal further teaches wherein the search report comprises an advertisement selected based on the external network search request (see col.4, lines 41-44).

As per **claims 12 and 24**, which depend on claims 1 and 13, respectively, Singhal further teaches generating a third search request in response to the original search request, the third search request to cause a search to be performed on electronic documents available via a second network portal of the external network according to the search parameters of the original search request; analyzing search results of the local network search request, the external network search request, and the third search request; and generating the single search report in response to the analysis of the search results, wherein the single search result is generated in accordance with a format specified by the electronic device (see claim 1, 13, and 25 rejection above; and col.1, lines 36-37: "submits the search query to a plurality of search engine devices")

As per **claims 30 and 31**, which depends on claim 25, Singhal further teaches wherein external document search is performed by an Internet portal (see col.10, line 40: Internet, and Fig.1, no.150) and wherein the search of captured electronic documents is performed by the device (see col.10, lines 24-34).



As per **claim 37**, which depends on claim 25, Singhal further teaches wherein the first device further generates a second external network search request to the external network which is performed by a third device on the external network and analyzes the search results of the captured electronic documents, the external document search request, and the second external network search request, wherein the single search report is generated in response to the analysis of the search results and the single search report is generated in accordance with a format specified by the first device (see claim 12 and 24 rejection above and col.3, lines 31-45).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal (US 6370527 B1) as applied to claims 1, 7, 13, and 19 above, and further in view of Rakavy et al. (US 5913040 A). Singhal teaches all the limitations of **claims 11 and 23**, except wherein the search report comprises an advertisement selected based on analysis of documents indicated by search results. Rakavy teaches of a search report comprising an advertisement selected based on analysis of documents

indicated by search results (see col.1, lines 20-22 & 35-42). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to employ the teaching of Rakavy within the system of Walls, by employing search reports comprising an advertisement generated from search results, because this would allow searching systems like Walls' to generate revenue from companies who wish to advertise to customers using such systems, in similar fashion to web site advertising methods currently employed. Furthermore, Singhal suggests the employment of advertising within the multi-search method and program (see col.4, lines 41-44).

6. Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal (US 6370527 B1) as applied to claims 1, 7, 13, and 19 above, and further in view of Nasr et al. (US 6263332 B1). Singhal teaches all the limitations of **claims 8 and 20**, except wherein the search report is one of a Hypertext Markup Language (HTML) document and an Extensible Markup Language (XML). Nasr teaches of a search report is one of a Hypertext Markup Language (HTML) document and an Extensible Markup Language (XML) (see col.2, lines 20-27 and col.8, lines 7-8 & 61-64. It would have been obvious to a person of ordinary skill in the art to employ the teachings of Nasr within the system of Singhal by implementing HTML and XML documents within the searching method and program because Singhal teaches that the networks may comprise an Internet and Nasr teaches that XML and HTML are languages for establishing documents in the Internet or World Wide Web.

***Response to Remarks***

7. Applicant's arguments filed November 7, 2005 have been fully considered but they are not persuasive. *Singhal* teaches each and every element of the claimed invention.

The applicant(s) argue that *Singhal* only discloses a single network and not a local and external network. In column 3, lines 15-29 as cited in the office action and referenced in the arguments, specifically lines 23-29, *Singhal* explicitly states:

Furthermore, the network 120 may include a plurality of data networks, a plurality of telecommunications networks, a combination of data and telecommunications network...

Clearly, *Singhal* suggests a plurality of networks can be applied and any combination thereof. It is clear from the recitation that the network shown in Fig.3 is for simplicity and not intended to limit the invention. Also with regards to the argument that no search requests are mentioned in the cited section, the cited section is primarily to teach the different networks applicable. The examiner did not specifically cite the "searching element" because the whole invention of *Singhal* deals with searching, wherein the searching is performed via the network (see col.3, lines 32-38). However to clarify the matter, this reference location has been provided above.

For the reasons above, claims 1, 13, and 25 remain rejected as well as the depending claims.

8. In response to the argument regarding claims 11 and 23, *Rakavy* need not teach the above-mentioned elements because *Singhal* clearly and explicitly teaches them. For the reasons above, claims 11 and 23 remain rejected.

9. In response to the argument regarding claims 8 and 20, *Nasr* need not teach the above-mentioned elements because *Singhal* clearly and explicitly teaches them. For the reasons above, claims 8 and 20 remain rejected.

### ***Conclusion***

10. Claims 1-25, 30, 31, and 35-37 have been rejected and are pending

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



December 19, 2005



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SUPERVISORY PATENT EXAMINER

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